

Appl. No. 09/558,465
Atty. Docket No. 7548M
Amdt. dated August 11, 2003
Reply to Office Action of February 10, 2003

REMARKS

Claims 1 - 34 are pending in the present application. No additional claims fee is believed to be due.

Claim 1 has further been amended to further define the present invention wherein the matter of Claim 10 has been incorporated into Claim 1. Further, Claim 1 has been amended to more particularly define the present invention, by further defining the anti-dandruff agent as an anti-dandruff particulate. Support for this amendment can be found in originally filed Claim 15 of the present application, as well as found in the Specification on page 22 line 22 wherein the anti-dandruff agent may be particulate or soluble. Likewise, Claims 13-16 have been amended to further define the present invention comprising an anti-dandruff particulate.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Double Patenting Rejection

Claims 1-34 have been rejected as claiming the same invention as that claimed in Applications 09/558,466 and 09/558,447. In response, Applicants are submitting herewith a Terminal Disclaimer. Applicants contend that the Terminal Disclaimer moot the double patenting rejection.

Rejection Under 35 USC 112, Second Paragraph

The Office Action States that Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Accordingly, Claim 12 has been amended to delete the term "dispersed" as it was viewed as indefinite and unclear. Support for the amendment is found, at least, at page 9 lines 33-35 of the specification.

Invention Synopsis

The present invention discloses a shampoo composition comprising from about 5% to about 50%, by weight, of an anionic surfactant; from about 0.01% to about 10%, by weight, of a non-volatile conditioning agent; from about 0.1% to about 4%, by weight, of an anti-dandruff particulate; from about 0.02% to about 5%, by weight, of a cationic polymer; water; from about 0.1% to about 10%, by weight of the composition, of a suspending agent; wherein said composition has a bioavailability/coverage index value, of at least about 1.25; has a first

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conditioning index value, of less than or equal to about 1.0; has a second conditioning index value, of at least about 1.5; and has a minimal inhibitory concentration index value, of at least about 0.125.

35 U.S.C. § 102(b)

Claims 1-9, 12-14, 16, 18-20, 30 and 32 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ramachandran et al (WO 96/29983). Applicants respectfully traverse this rejection since Ramachandran et al. do not disclose a formulation containing all of the elements of Applicants' claimed invention. Specifically, Ramachandran et al. do not disclose the combination of a cationic guar derivative with a non-volatile conditioning agent. The conditioning agents are listed as one of many possible ingredients in the final shampoo composition. Within the category of conditioning agents, cationic guar is mentioned in a long list of potential ingredients, none of which is required. The cationic guar is not included in any of the specific examples, and it is not combined with a conditioning agent.

The possible shampoo formulations that can be devised by selecting items from Ramachandran's optional ingredients number in the hundreds. A shampoo combining an anionic surfactant, a non-volatile conditioning agent, an anti-dandruff particulate, a cationic guar derivative and water is only one of these hundreds of possible shampoo formulations. There is no embodiment of this combination. In fact, there is no example that includes a cationic guar derivative. Therefore, Applicants contend that the Ramachandran reference does not anticipate Applicants' claim 1.

Further, as now amended, the present invention is directed towards a shampoo composition comprising a suspending agent, such as ethylene glycol distearate. In the outstanding Office Action, Ramachandran et al was not cited on the grounds of 102 (b) against Claims 10 and 11 of the present invention, which were directed toward a suspending agent. To more distinctly define the present invention, as now amended, the matter of Claim 10 has now been incorporated into Claim 1.

The Rejection under 35 U.S.C. 102(e) over Guskey

Claims 1-12, 18-29 and 31 have been rejected under 35 U.S.C. 102(e) as being anticipated by Guskey (US 5,977,036). Applicants respectfully traverse this rejection since Guskey does not specifically disclose the anti-dandruff particulate claimed by Applicants. In addition, Applicants' claimed range of anti-dandruff particulate is not disclosed with sufficient specificity in Guskey to qualify as anticipation.

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First, Applicants' claim 1 requires the presence of from about 0.1% to about 4% of an anti-dandruff particulate. The anti-dandruff component is required to be a particulate since the invention concerns depositing the anti-dandruff component from a coacervate-forming shampoo. Guskey, in Col. 17, line 38, mentions "anti-dandruff agents" as one of many possible optional components. The term "anti-dandruff agent" is broader than just particulates and includes all other forms (e.g. liquid, etc.) of anti-dandruff compositions. The Guskey reference does not disclose anti-dandruff particulates.

Second, Applicants' claim 1 specifies that "from about 0.1 to about 4%" of the anti-dandruff particulate is present. Guskey's disclosure of "from about 0.001% to about 10%" for any of the optional components does not qualify as an anticipation of Applicants' claimed range. For a prior art range to anticipate the claimed invention's range, it must be disclosed with "sufficient specificity" (see MPEP 2131.03). Applicants contend that Guskey's range is too broad to sufficiently specify Applicants' range of from about 0.1 to about 4%. For example, Applicants' low end of the range is one hundred times higher than that disclosed in Guskey.

Guskey's brief mention of anti-dandruff agents as one of many optional ingredients and a blanket range for any of the optional ingredients does not anticipate Applicants' claim 1. Guskey does not teach using an anti-dandruff particulate, as claimed by Applicants. Further, Guskey's disclosed range is too broad to anticipate Applicants' claimed range of anti-dandruff particulate. Therefore, Applicants contend that the claimed invention is novel and that the rejection should be withdrawn.

The Rejection under 35 U.S.C. 103(a) over Ramachandran et al

Claims 1-9, 12-14, 16, 18-20, 30 and 32 have been rejected under 35 U.S.C. as being unpatentable over Ramachandran et al (WO96/29983). Further, Claims 1-12, 18-29 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Guskey. The outstanding Office action states that Ramachandran et al and Guskey do not explicitly disclose the bioavailability/coverage index, the conditioning index value, or the minimal inhibitory concentration index values. However, since it is asserted that Ramachandran et al and Guskey teach the applicant's instant composition, it is deemed that the index values, as described above, are implicit in the teachings of the reference. Applicants respectfully traverse this rejection. As demonstrated above, Applicants have earlier demonstrated that neither Ramachandran et al nor Guskey anticipate the applicant's instant composition. As further demonstration regarding the rejection under 103 (a), Applicants respectfully submit a Declaration of David S Dunlop under 37 C.F.R. 1.132. The attached declaration demonstrates that surprisingly not all formulas with similar components met

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the criteria for the specified and required indexes of the present invention. Formula A, representative of the present invention, meets the criteria as outlined in the present invention's Claim 1 for bioavailability/coverage index and the second conditioning index. Formula B, an example of another conditioning shampoo, meets none of the criteria for the bioavailability/coverage index and the second conditioning index. Formula C, which would be representative of a formula similar to that described in Ramachandran et al, does not meet the criteria for the second conditioning index, as required by the present invention. Therefore, Applicants have demonstrated that it is not implicit in the teachings of Ramachandran et al or Guskey that such index values would be present. Applicants have surprising found through much investigation and invention, the specific criteria required to meet the specified and distinct index values, as defined and claimed, in order to achieve the surprising benefits of the present invention.

Therefore, the present invention is neither disclosed nor made obvious in view of Ramachandran et al or Guskey.

The Rejection under 35 U.S.C. 103(a) over Guskey and Cardin

Claims 1-13 and 15-34 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Guskey in view of Cardin (U.S. Patent 5,104,645). Applicants respectfully traverse this rejection because the Guskey reference is not available as prior art against the present application under 35 U.S.C. §103(c).

Guskey issued on November 2, 1999. The present application has a priority date of May 3, 1999. This means that the Guskey reference only qualifies as prior art under 35 U.S.C. §102(e). Furthermore, the present application and the Guskey reference were, at the time the claimed invention was made, owned by, or subject to an obligation of assignment to, the Procter & Gamble Company.

35 U.S.C. §103(c) applies to U.S. patent applications filed after November 29, 1999. Since the current application has a filing date after November 29, 1999 (a non-provisional application was filed on April 25, 2000), Applicants contend that Guskey is not available as a reference under 35 U.S.C. §103(c).

Further, 35 U.S.C. §103(c) and MPEP §2146 explain that 35 U.S.C. §103(c) applies to all sections of 35 U.S.C. §103. MPEP §2146 states that "prior art...under 35 U.S.C. §102 (e), (f), and (g) is not to be considered when determining whether an invention is obvious under 35 U.S.C. §103, provided the subject matter and the claimed invention were commonly owned at the time

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the invention was made". Thus, Guskey is not available as a 35 U.S.C. §103(a) reference because of the 35 U.S.C. §103(c) provision.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. 112, 102 (b), 102(e) and 103(a). Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-34.

Respectfully submitted,

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